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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
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2192

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,458

Applicant(s)

JACOBI ET AL

Examiner

Hoang-Vu A. Nguyen-Ba

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-37 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment filed March 14, 2005.

Response to Amendments

2. Per Applicants' request, Claims 1, 6-7, 9-16, 18-35 have been amended; new Claims 36 and 37 have been added. Claims 1-37 are pending.
3. The objection to the Declaration is withdrawn in view of Applicants' filing of a substitute Declaration that addresses objections raised in the previous Office action.
4. The rejection of Claims 10-12, 14-15, 27, 30 and 32 under 35 U.S.C. § 112, second paragraph as being indefinite is withdrawn in view of Applicants' amendments to these Claims to provide proper antecedent basis to the identified terms.
5. The rejection of Claims 19, 23-24, 25, 31 and 34-35 under 35 U.S.C. § 101 is withdrawn in view of Applicants' amendments to the claims to direct these Claims to statutory subject matter.

Response to Arguments

5. Applicant's arguments filed March 14, 2005 have been fully considered but they are not persuasive. Following is an examiner's response to Applicants' arguments.

- a. **Rejection of Claims 1-10, 19-27 and 35 under 35 U.S.C. § 102(a):**

- Claim 1:**

- Applicants' arguments:

- The Applicants respectfully traverse the rejection. Regarding amended claim 1, the Applicants submit that the Inaba reference does not teach, suggest, or disclose, for example, a method for updating an electronic device, the method comprising updating a first code version in the electronic device to a second code version using update information comprising a set of instructions for converting the first code

version to the second code version, and converting data associated with the first code version to a form compatible with the second code version.

Therefore, for at least the above stated reasons, the Applicants respectfully submit that Inaba is different from and fails to anticipate the Applicants' invention as set forth in claim 1, as amended. Because claims 2-18 and 36 depend either directly or indirectly upon claim 1, Inaba is different from and fails to anticipate claims 2-18 and 36, as well.

Examiner's response:

The examiner interprets amended Claim 1 to mean that the version of a first code is updated to that of a second code using update instruction code. The examiner notes that the set of instructions for converting the first code version to the second code version is deemed inherent to Inaba as paragraph [0010], lines 7-8 shows that the system moves into an operational state that matches the result of the upgrade. Without proper instructions code, this operation could not be automatically performed as disclosed.

Claim 19

Applicants' arguments:

Applicants essentially argue that Inaba does not teach the limitations of amended Claim 19.

Examiner's response:

See discussion set forth above in the examiner's response to Applicants' arguments regarding Claim 1.

b. Rejection of Claims 11-18 and 29-34 under 35 U.S.C. § 103(a):

Applicants' arguments:

Regarding claims 11-18, claims 11-18 depend directly or indirectly upon amended independent claim 1. Because amended claim 1 is allowable, the Applicants respectfully submit that claims 11-18 are allowable over the proposed combination of references.

Examiner's response:

Since Claims 1 and 19 are not allowable for the reasons set forth in the examiner's response to Applicants' arguments regarding Claims 1 and 19, Claims 11-18 and 29-34 are not in condition for allowance because the features recited in these claims are unpatentable over Inaba in view of Hsu.

According to the foregoing discussion, the rejections of Claims 1-35 are maintained.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-10, 19-27 and 35 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent Application No. 2001/0008024 A1 by Inaba.

Claims 1 and 19

Inaba discloses at least:

updating a first code version in the electronic device to a second code version using update information comprising a set of instructions for converting the first code version to a second code version (see at least sections [0010], [0025-0028]); and

converting data associated with the first code version to a form compatible with the second code version of the at least one of firmware and software (see at least sections [0011], [0014], [0027], [0028]).

Claim 2

The rejection of base claim 1 is incorporated. Inaba does not specifically disclose *retrieving a list of names of converter utilities associated with the update information*. However, this step is deemed inherent to Inaba teachings because as can be seen in Figure 1 (and related discussion in the specification), steps 8, 9 provide information about data conversion which may also provide list of converter utilities.

Claims 3 and 22

The rejection of base claims 1 and 19 is incorporated. Inaba further discloses *storing update information in at least a portion of memory in the electronic device* (see at least Figure 1, items 7, 8 and related discussion in the specification).

Claim 4

The rejection of base claim 1 is incorporated. Inaba further discloses *communicating queries regarding availability of update information from the electronic device to a server* (see at least Figure 1, steps 2, 3, 4 and related discussion in the specification).

Claims 5 and 21

The rejection of base claims 1 and 19 is incorporated. Inaba further discloses *retrieving the update information and a list of names of converter utilities in a single retrieval operation* (see at least Figure 1, step 7 and related discussion in the specification).

Claims 6 and 23

The rejection of base claims 1 and 19 is incorporated. Inaba further discloses *wherein the first code version comprises a plurality of software applications, and each of the plurality of software applications is associated with a corresponding converter utility* (see at least Figure 3, item 8-1 and related discussion in the specification).

Claims 7 and 24

Rejections of base claims 1, 19 and intervening claims 6, 23 are incorporated. Inaba further discloses *wherein the update information is capable of updating the plurality of software applications in a single update event* (see at least Figure 1, step 7 and related discussion in the specification).

Claim 8

The rejection of base claims 1 and 19 is incorporated. Inaba further discloses *further comprising generating an update package reference, the update package reference at least comprising:*

an update package location memory reference (see at least Figure 3, item 8-1 and related discussion in the specification); and

a list of names of converter utilities memory reference (see at least Figure 3, item 8-1 and related discussion in the specification).

Claims 9 and 26

The rejection of base claims 1 and 19 is incorporated. Inaba further discloses *determining whether a code update is necessary, wherein if it is determined that an update is not necessary, then performing a reboot operation* (see at least section [0026]).

Claims 10 and 27

The rejection of base claims 1 and 19 is incorporated. Inaba further discloses *determining whether a code update is necessary, wherein if it is determined that an update is necessary, then:*

retrieving data from an update package reference (see at least Figure 1, steps 5, 7 and related discussion in the specification);

verifying authenticity of the update information (see at least Figure 1, item 2 and related discussion in the specification);

updating the first code version (see at least section [0026]);

executing at least one converter utility associated with at least one software application (see at least section [0028]);

communicating an update confirmation to at least one external system (see at least sections [0034], [0037]; e.g., notification); and

performing a reboot operation (see at least section [0026], e.g., start-microprocessor request).

Claim 20

The rejection of base claim 19 is incorporated. Claim 20 recites the same limitations of the combination of claims 2 and 4. Therefore, the same rejections are applied.

Claim 25

The rejection of base claim 19 is incorporated. Inaba does not specifically disclose *a placement layout table for mapping a memory location of update information, the placement layout table at least mapping an update information memory location and a list of names of converter utility memory location*. However, this table is deemed inherent to Inaba's

teachings as Figure 1 shows conversion operations between items 3 and 5. Without a table as claimed, the conversion process would not be feasible.

Claim 35

The rejection of base claim 19 is incorporated. Inaba further discloses *wherein a software application is updated when data associated with the software application changes* (see at least section [0025]).

Claim 36

The rejection of base claim 1 is incorporated. Inaba further discloses *wherein code comprises firmware* (see at least sections [0010], [0025-0028]).

Claim 37

The rejection of base claim 19 is incorporated. Inaba further discloses *wherein code comprises firmware* (see at least sections [0010], [0025-0028]).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11-18 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2001/0008024 A1 by Inaba, as applied to claims 1-10 and 19-27, in view of U.S. Patent No. 6,587,684 to Hsu et al. ("Hsu").

Claim 11

Rejections of base claim 1 and intervening claim 10 are incorporated. Inaba does not specifically disclose *wherein executing at least one converter utility associated with the at least one software application comprises retrieving and updating associated security information*. However, Hsu, in an analogous art, teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's security and authentication features in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claim 12

Rejections of base claim 1 and intervening claims 10, 11 are incorporated. Inaba does not specifically disclose *wherein retrieving and updating associated security information comprises retrieving an authorization related object and associating it with the at least one software application*. However, Hsu, in an analogous art, teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone

services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's security and authentication features in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claim 13

Rejections of base claim 1 and intervening claims 10, 11 are incorporated.

Inaba does not specifically disclose:

retrieving a list of security information associated with the update information; and installing the security information after updating the first code version. However, these features are deemed inherent to the teachings of Hsu since Hsu teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's security and authentication features in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claim 14

Rejections of base claim 1 and intervening claim 10 are incorporated. Inaba does not specifically disclose *wherein executing at least one converter utility associated with the*

at least one software application comprises converting security information comprising authentication and authorization information. However, these features are deemed inherent to the teachings of Hsu since Hsu teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's security and authentication features in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claim 15

Rejections of base claim 1 and intervening claim 10 are incorporated. Inaba does not specifically disclose *wherein executing at least one converter utility associated with the at least one software application comprises converting subscription information.* However, these feature is deemed inherent to the teachings of Hsu since Hsu teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's teachings in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claims 16 and 28

Rejections of base claims 1, 19 and intervening claims 10, 27 are incorporated. Inaba further discloses *wherein the first code version comprises a plurality of software applications, and the at least one converter utility comprises a plurality of converter utilities, each converter utility being associated with a corresponding software application* (see at least Figure 3, item 8-1 and related discussion in the specification).

Claims 17 and 29

Rejections of base claims 1 & 19 and intervening claims 10, 16 & 27, 28 respectively are incorporated. Inaba further discloses *wherein each of the software applications for which an update was determined to be necessary is updated in a single update event* (see at least Figure 1, step 7 and related discussion in the specification).

Claims 18 and 30

Rejections of base claims 1 & 19 and intervening claims 10, 16, 17 & 27, 28, 29 respectively are incorporated. Inaba further discloses *wherein executing at least one converter utility associated with the at least one software application further comprises converting data associated with each software application in a single conversion event* (see at least Figure 1, step 9 and related discussion in the specification).

Claim 32

The rejection of base claim 19 and intervening claims 20-21 are incorporated. Inaba does not specifically disclose *a communication layer, the communication layer communicating converter utilities, the converter utilities adapted to converting security data and access control information associated with the update information, and the communication layer also communicating information associated with the converted security data and access control information from the electronic device to a server*. However, Hsu, in an analogous art, teaches how a

digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's security and authentication features in Inaba because this would prevent unauthorized use of the telephone and data networks.

Claim 33

The rejection of base claim 19 and intervening claims 20-21 are incorporated. Inaba further discloses *wherein a converter utility invokes downloading of update information and firmware/software update information* (see at least sections [0034-0037]).

Claim 31

The rejection of base claim 19 is incorporated. Inaba does not specifically disclose *the converter converts security data associated with the at least one of firmware and software, the converted security data enabling access to the updated version of the at least one of firmware and software*. However, Hsu, in an analogous art, teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Hsu's security and authentication features in

Inaba because this would prevent unauthorized use of the telephone and data networks.

Claim 34

The rejection of base claim 19 is incorporated. Inaba does not specifically disclose *wherein security information is updated after a software/firmware update has been performed*. However, Hsu, in an analogous art, teaches how a digital telephone can connect to selected servers via a digital telephone network and packet data network to download selected control software associated with digital telephone services (14:9-13). Connection is established using authentication with security features (15:7-50) to prevent unauthorized use of the telephone and data networks.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add to Inaba Hsu's security and authentication features that need to be changed regularly because this would prevent unauthorized use of the telephone and data networks.

Conclusion

10. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS from the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the

advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 7:15 to 17:15.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ANTONY NGUYEN-BA
PRIMARY EXAMINER**

Art Unit 2192

June 8, 2005